

IN THE PATENT AND TRADEMARK OFFICE

In re the Application of
Andre Colas et al.

Serial No: 09/304,393

Filed: May 4, 1999

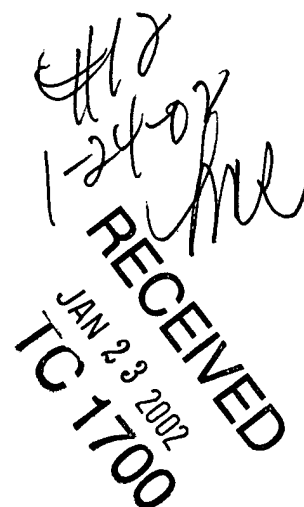
Title: METHOD FOR ADHERING
SUBSTRATES USING ADHESIVE
DEVICES CONTAINING SILICONE
GELS

Docket Number: VN24

) Group Art Unit: 1771

) Examiner: D. Zirker

) Dated: October 25, 2001



To the Honorable Commissioner
of Patents and Trademarks
Washington, D.C. 20231

Sir:

APPEAL BRIEF

This is an appeal from the action of the Examiner dated 5/25/01, finally rejecting claims 1-6
and 8.

(1) REAL PARTIES IN INTEREST

The Applicants are as stated above. The Application has been assigned to Dow Corning
France S.A..

(2) RELATED APPEALS AND INTERFERENCES

Neither the Applicants, the Applicants' legal representative nor the Assignee are aware of

any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) STATUS OF CLAIMS

Claims 1-6 and 8 stand finally rejected. Claims 7 and 9 are objected to as being dependent on a rejected claim. Claim 10 is allowed.

(4) STATUS OF AMENDMENTS

Applicants have not filed an amendment after final.

(5) SUMMARY OF THE INVENTION

Applicants' invention comprises a method for adhering a first substrate to a second substrate with an adhesive device comprising a carrier sheet, said carrier sheet having at least two surfaces Page 5, line 25 – page 6, line 12). On one surface of the carrier sheet is a first, continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m² (page 6, line 13 – page 8, line 8) This gel has sufficient tack to adhere to the first substrate (page 8, line 9 – page 8, line 32). On a second surface of the carrier sheet is a second continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m² (page 6, line 13 – page 8, line 8). This gel has sufficient tack to adhere to the second substrate (page 8, line 9 – page 8, line 32). Examples of substrates that can be adhered are included on page 11, line 27 – page 12, line 6 of the specification and include medical prosthesis on patients, electrical components, and construction elements.

(6) ISSUES

The issues to be resolved are:

1. Whether claims 1-6 and 8 are patentable under 35 U.S.C. § 103(a) as being obvious over WO 9609076; and
2. Whether claims 1-6 and 8 are patentable under 35 U.S.C. § 103(a) as being obvious over GB 2,192,142.

(7) GROUPING OF CLAIMS

Applicants claims (1-6 and 8) will stand or fall together.

(8) ARGUMENTS

Issue 1

In the first office action, the Examiner also rejected claims 1-10 under 35 U.S.C. § 103 as being obvious over WO9609076A stating:

The reference is again relied upon substantially as set forth, above and if the reference is not considered precise enough (i.e., a large number of possible embodiments being disclosed) to constitute an anticipation, it can still clearly put the claimed invention within the ordinary skill of the art. Note the teaching of a non-woven carrier being coated on both outer surfaces with a continuous layer of a suitable silicone gel, which is substantially all that applicants' claims require. With respect to parameters such as the carrier density (claim 3), use of conventional release sheets (claim 6), and bonding a prosthesis to a human or animal body (claims 7, 9 and 10), these are each believed to be, if not expressly or inherently disclosed,

and obvious parameters to one in the medical adhesives art, in the absence of unexpected results.

In the Final Office Action, the Examiner stated:

Claim 1-6 and 8 are rejected under 35 USC 103(a) as being unpatentable over WO -076, substantially for the reasons set forth in paragraph Nos. 3 and 5 of paper No. 7, together with the following observations. Applicant argues that his claims are all related to a method, but the Examiner believes that the teachings of a suitable carrier sheet having continuous adhesive layers on both surfaces thereof of the type which applicant contemplates would be more than enough to put within the grasp of one of ordinary skill a method of bonding each surface to a suitable substrate which is all applicant's broad claim requires. The embodiments set forth at page 7, line 4 of the reference (response, page 3) is only one of multiple contemplated embodiments and applicant has made no additional arguments or accompanying showings to rebut the prima facie case of record.

Applicants traverse this rejection and respectfully request the Board's reconsideration.

WO 9609076 teaches a hypertrophic scar dressing which includes a silicone gel on that side of the dressing which lies against the user's skin when worn. (abstract)

As noted in the first response, Applicants' invention and the claims related thereto are primarily method (claims 1-6), specifically a method for adhering a first substrate to a second substrate with a silicon gel-containing composition. Even claim 8 which relates to a substrate requires "A substrate having an adhesive device for adhering it to a second substrate". The reference, on the other hand, does not teach this method. Specifically, nothing in the reference teaches, suggests, anticipates or renders obvious a method of using a silicone gel composition to

adhere a first substrate to a second substrate. In fact, the reference teaches away from the present invention when it suggests the inclusion of the top layer (4) which "...contributes towards increasing the wear strength, tensile strength and tear strength of the dressing, and in the majority of cases it is beneficial when the top sheet has a small coefficient of friction against clothing or other materials." Page 7, line 4 (emphasis added).

Applicant notes that the Examiner has focused on the composition as opposed to the method in the rejections. The method, the Examiner thereafter concludes, is obvious. For example, in the first rejection, the Examiner states:

"With respect to parameters such as ... bonding a prosthesis to a human or animal body (claims 7, 9 and 10), these are each believed to be, if not expressly or inherently disclosed, and obvious parameters to one in the medical adhesives art, in the absence of unexpected results."

In the final rejection the Examiner states:

...the Examiner believes that the teachings of a suitable carrier sheet having continuous adhesive layers on both surfaces thereof of the type which applicant contemplates would be more than enough to put within the grasp of one of ordinary skill a method of bonding each surface to a suitable substrate which is all applicant's broad claim requires.

The Examiner, thus, DEEMS the invention obvious without ANY showing thereof, in spite of the fact that the reference teaches away. Moreover, the Examiner states "...applicant has made no additional arguments or accompanying showings to rebut the prima facie case of record."

Applicants, however, contend that the Examiner is required to establish a prima facie case of obviousness before Applicant is required to respond and, in the present case, the Examiner has

failed to proffer any substantial showing that the silicone gels herein have been used for such purposes.

It is evident from the above discussion that the reference does not render the present invention obvious as required under 35 USC 103(a). Applicants, therefore, respectfully request the Board reconsider the Examiner's rejection and allow the claims to issue.

Issue 2

In the first office action, the Examiner rejected claims 1-10 under 35 U.S.C. § 103 as being obvious over GB2,192,142A (Brassington et al is cumulative) stating:

The reference is again relied upon substantially as set forth, above. With respect to obviousness, note that in certain embodiments the reference teaches a Fabric layer coated on both surfaces with a suitable continuous silicone gel, which is substantially all that applicants' claims require. With respect to the dependent claims (and claim 10), the Examiner's analysis is substantially the same as set forth in the prior obviousness rejection, above.

In the Final Office Action, the Examiner stated:

Claims 1-6 and 8 are rejected under 35 USC 103(a) as being unpatentable over GB -142, substantially for the reasons set forth in paragraph Nos. 6 and 7 of paper No. 7, together with the following additional observations. Applicant again argues that the reference fails to teach the nominal method steps which he claims, but the Examiner again believes that one of ordinary skill in the art, being aware that the reference teaches the claimed genus of adhesives coated on both surfaces (see e.g. Example 1) would find the claimed method

well within the ordinary skill in the art, in the absence of unexpected results.

Applicants again traverse this rejection and respectfully request the Board's reconsideration.

'142 teaches a wound dressing comprising a layer of apertured material, such as cotton gauze, coated with tacky silicone gel or a non-tacky silicone elastomer. (abstract)

This reference, however, has the same deficiencies as the above reference, i.e., nothing the Examiner cites teaches, suggests, anticipates or renders obvious the presently claimed invention for adhering a first substrate to a second substrate with a silicon gel-containing composition.

The Examiner again concludes that the present invention is obvious stating:

... the Examiner again believes that one of ordinary skill in the art, being aware that the reference teaches the claimed genus of adhesives coated on both surfaces (see e.g.

Example 1) would find the claimed method well within the ordinary skill in the art, in the absence of unexpected results.

Applicants again contend that the Examiner is required to establish a prima facie case of obviousness before Applicant is required to respond and, in the present case, the Examiner has failed to proffer any substantial showing that that the silicone gels herein have been used for such purposes.

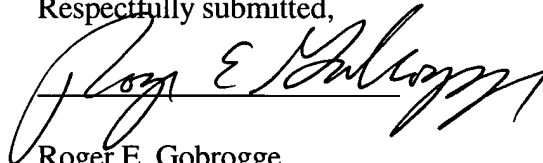
It is evident from the above discussion that the reference does not render the present invention obvious as required under 35 USC 103(a). Applicants, therefore, respectfully request the Board reconsider the Examiner's rejection and allow the claims to issue.

The present response is being submitted within the period of time for response.

Applicants believe that no extension of time is necessary. However, in the event that such an

extension is necessary, you are authorized to charge deposit account number 04-1520 any fees necessary to maintain the pendency of the present application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Roger E. Gobrogge", written over a horizontal line.

Roger E. Gobrogge
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9. APPENDIX

1. In a method for adhering a first substrate to a second substrate with an adhesive device, the improvement comprising the use of an adhesive device comprising:
 - a carrier sheet, said carrier sheet having at least two surfaces;
 - on one surface of the carrier sheet is a first, continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m²; said gel having sufficient tack to adhere to the first substrate; and
 - on a second surface of the carrier sheet is a second continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m², said gel having sufficient tack to adhere to the second substrate.
2. The method according to Claim 1 in which the carrier sheet is non-woven and continuous and is made from a material selected from the group consisting of polysaccharide based materials, polyethylene, polyamide, polyurethane, nylon, polyester, polypropylene, polytetrafluoroethylene, and silicone.
3. The method according to Claim 1 in which the carrier sheet has a density of about 5 to 150 g/m² and a thickness in the range of about 0.01 to about 1 mm.
4. The method according to Claim 1 in which the first and second continuous layers of silicone gel are formed by the reaction of a silicone having Si-H groups with a silicone having Si-aliphatically unsaturated groups in the presence of a platinum or rhodium catalyst.
5. The method according to Claim 1 in which the first and second continuous layers of silicone gel have a thickness in the range of about 0.2 to 5 mm.
6. The method according to Claim 1 in which the first and second continuous layers of silicone gel are covered by release liners.
7. The method according to Claim 1 in which the first substrate is a prosthesis and the second substrate is a human or an animal body.

8. A substrate having an adhesive device for adhering it to a second substrate comprising:
a substrate having a surface to be adhered to a second substrate; and
on the surface of the substrate to be adhered to the second substrate, an adhesive device comprising:
a carrier sheet, said carrier sheet having at least two surfaces;
on one surface of the carrier sheet is a first, continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m²; said gel having sufficient tack to adhere to the substrate; and
on a second surface of the carrier sheet is a second continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m², said gel having sufficient tack to adhere to the second substrate,
wherein the first continuous layer of silicone gel of the adhesive device is adhered to the surface of the substrate to be adhered to a second substrate.
9. The substrate according to Claim 8 wherein the substrate is a prosthesis and the second substrate is a human or animal body.
10. A method for adhering a prosthesis to a human or an animal body comprising:
positioning an adhesive device between the prosthesis and the human or animal body; and
compressing the adhesive device between the prosthesis and the human or animal body,
wherein the adhesive device comprises:
a carrier sheet, said carrier sheet having at least two surfaces;
on one surface of the carrier sheet is a first, continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m²; said gel having sufficient tack to adhere to the prosthesis; and
on a second surface of the carrier sheet is a second continuous layer of a silicone gel having a density in the range of about 100 to 4500 g/m², said gel having sufficient tack to adhere to the human or animal body.

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Applicant(s): Andre Colas et al.

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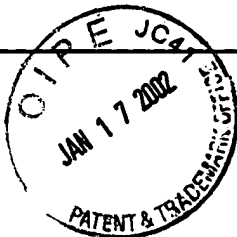
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Examiner
D. Zirker

Group Art Unit
1771

Invention: **METHOD FOR ADHERING SUBSTRATES USING ADHESIVE DEVICES CONTAINING SILICONE GELS**



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1771


Invention: METHOD FOR ADHERING SUBSTRATES USING ADHESIVE DEVICES CONTAINING SILICONE GELS

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on

The fee for filing this Appeal Brief is: \$320.00

- ☐ A check in the amount of the fee is enclosed.
- ☒ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 04-1520
A duplicate copy of this sheet is enclosed.


Signature
Roger E. Gobrogge
Phone: (989) 496-3107

Dated: 10-26-01

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